



Serial No.: 09/777,492

Docket No.: 257/103

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : Stephen B. Bove, et al.
Serial No. : 09/777,492
Filing Date : February 5, 2001
Title : System and Method for Anonymous Lead Generation
and Management
Group/Art Unit : 3628
Examiner : Siegfried E. Chencinski

Confirmation No. : 8359
Docket No. : 257/103

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant Requests review of the final rejection made in the Office Action of
February 13, 2006 in the above-identified application.

- No amendments are being filed with this request.
- This request is being filed concurrently with a Notice of Appeal, along with a
Petition for Extension of Time and requisite fee.
- The review is requested for the reasons stated in the "Remarks" section on the
attached sheets.

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REMARKS

In response to the Office Action dated February 13, 2006, and in conjunction with the Notice of Appeal submitted herewith, Applicant requests review of the final rejection of claims 1-25 of the above-identified application for the following reasons:

1. The examiner has failed to make a prima facie showing that any of the claims of the present application are anticipated under § 102(e).

In the Office Action, under the heading "Claim Rejections – 35 U.S.C. §103", the examiner states that claims 1, 3, 5-9, 12-16, and 18-20 are rejected under 35 U.S.C. §102(e) as being **anticipated** by U.S. Patent No. 6,574,608 to *Dahod et al* (hereinafter "*Dahod*").

Specifically addressing independent claims 1, 9, and 16, the examiner then states that "*Dahod* does not explicitly disclose a database which stores device identifying information" (see page 2, first sentence of final Office Action), and that "[a]n ordinary practitioner of the art ... would have seen it as **obvious** that *Dahod's* teachings **suggest** retention by the middle man" (emphasis added). Thus, the examiner is admitting that a claimed element (i.e., device identifying database) is not present in *Dahod*, but that it would have been **obvious** to one skilled in the art to include that element. Thus, Applicant believes that the examiner is, in fact, making a §103 obviousness rejection, which Applicant addresses in detail below. In any event, the disclosure of *Dahod*, and the examiner's statements regarding *Dahod*, make clear that the cited art does not support a §102(e) rejection of the claims.

2. The Examiner has failed to make a prima facie showing that claims 1-20 are obvious under 35 U.S.C. § 103(a) over *Dahod*.

The examiner states that "Dahod does not explicitly disclose a database which stores device identifying information", but that it would have been obvious to an ordinary practitioner in the art to retain device identifying information of both buyers and sellers (see page 2 of final Office Action). The examiner further states that the retention of cookies planted by Web site operators has been "done routinely ... for many years", and that a middle man facilitator's system "had, could have, or should have" saved that information in the respective database files of the participating parties, and that the motivation to do so is "to connect prospective buyers and sellers with each other more easily, efficiently and inexpensively" (see page 2 of final Office Action).

Independent claim 1 of the present application requires, among other things, "maintaining a prospect database identifying device-identifying information and corresponding prospect information comprising prospect-identifying information, anonymously submitted search criteria, and search information corresponding to said search criteria". Similarly, independent claim 9 of the present application requires "a database for storing prospects having anonymously submitted search criteria", and independent claim 16 of the present application requires the step of "generating a prospect having anonymously submitted search criteria".

As admitted by the examiner, "*Dahod* does not explicitly disclose a database which stores device identifying information" (see page 2 of final Office Action). In stating that it would have been obvious to one skilled in the art to modify *Dahod* to include a device identifying database, the examiner relies solely on his assertion that cookies have been used "for many years" in Internet applications, and that a facilitator of an Internet system "could have or should have" implemented such a tracking system.

First, Applicant notes that the present application has also been pending "for many years" (since 2001), and submits that the use of tracking cookies at that point in time would not have been obvious to one skilled in the art.

Furthermore, the examiner's statement that *Dahod* "could have" been modified to use cookies is not an appropriate grounds for establishing obviousness. Establishing prima facie obviousness requires not just that a modification "could have" been made, but that there be a basis in the art for making the suggested modification (MPEP § 2143.01). Here, there is no teaching, suggestion, or disclosure in *Dahod* (which requires registration and sign-in by users/buyers, *see Dahod*, column 5, lines 7-20), to implement an anonymous method of device tracking as claimed in the present application. In fact, by requiring registration by users, *Dahod* teaches away from the anonymous lead generation system claimed in the present invention.

Finally, the invention claimed in the present application solves a problem that is not taught, disclosed, or suggested in the prior art. As stated in paragraph [14] of the present application, one of the objects of the present invention is to enable generation of business leads which are completely anonymous. That anonymity extends even to the provider of the lead generation system who is "unable to identify the consumer" (see paragraph [14] of present application). *Dahod*, on the other hand, requires registration of buyers and sellers and the submission of personal, identifying information which eventually is exchanged once a deal is reached between the buyer and the seller. It makes no sense to modify *Dahod*, as suggested by the examiner, to include an anonymous device-identifying database as claimed in the present application. Simply adding such a database to the *Dahod* system would not produce anonymous leads, as the users in *Dahod* are required to register with personal information. And replacing

the user registration requirement in *Dahod* with the device-identifying database of the present application is non-sensical, since the anonymity of such a system would prevent buyers and sellers from contacting each other, which is the purpose of the system of *Dahod*. Since the modification to *Dahod* suggested by the examiner would not yield the invention claimed in the present application, the claims of the application are not obvious in view of the cited art, and the examiner's rejection should be withdrawn.

In summary, the system of *Dahod* and the system claimed in the present application are antithetical, with *Dahod* collecting personal information and exchanging that information between registered buyers and sellers, and the system claimed in the present application, generating leads of users who remain completely anonymous. There is absolutely no suggestion in the art to modify *Dahod* as suggested by the examiner, and doing so would yield only a non-sensical system, not the anonymous lead generating system claimed in the present application. Thus, independent claims 1, 9, and 16 of the present application (and thus dependent claims 2-8, 10-15, and 17-20) are not obvious in view of *Dahod*, and the examiner's rejection should be withdrawn.

3. The Examiner has failed to make a prima facie showing that claims 21-23 are obvious under 35 U.S.C. § 103(a) over *Dahod* in view of U.S. Published Application No. 2002/0169626 to *Walker*, or that claims 24 -25 are obvious over *Dahod* in view of *Walker* in further view of U.S. Patent No. 6,662,199 to *Flight*.

Independent claim 21 of the present application requires, among other things, storing search criteria in association with search-requestor information, without a requirement of user registration. As discussed above, the buyer-driven system of *Dahod* teaches away from a

non-registration system, and specifically requires users to register in order to receive proposals from the system (see *Dahod*, column 5, lines 7-21. Similar to *Dahod*, *Walker* requires that merchants register in the system with their contact information (see FIG. 9, and paragraph [0062] of *Walker*). Thus, like *Dahod*, *Walker* also teaches away from a non-registration system as claimed in claim 21 of the present application.

As stated in MPEP §2145, it is improper to combine or modify references where the references teach away from that combination or modification. Here, *Dahod* and *Walker* each teach away from allowing users to access the system without first registering. There is absolutely no disclosure, teaching, or suggestion in either *Dahod* or *Walker* to allow anonymous use of the system, as required in claim 21 of the present application. Nor would it even make sense to do so, since the systems of *Dahod* and *Walker* are intended to match an identifiable buyer to an identifiable seller. Thus, for at least this reason, the examiner's rejection of claims 21-25 is unsupported by the art, and should be withdrawn.

In addition, claim 21 of the present application requires storing search criteria in association with search-requester information. Neither *Dahod* nor *Walker*, nor their combination, make any teaching, suggestion, or disclosure of storing such search criteria. As stated in MPEP §2143.01, the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. There is no suggestion of the desirability of storing search criteria in either *Dahod* or *Walker*, thus, the Examiner's proposed combination of *Dahod* and *Walker* also fails to suggest the storing of such criteria. For this additional reason, the Examiner's rejection of claim 21 should be withdrawn.

Claims 22-25 depend from claim 21. Since claim 21 is allowable for the reasons just discussed, claims 22-25 are thus also allowable.

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In view of the foregoing remarks, it is respectfully submitted that the claims of the present application are in condition for allowance and eventual issuance. Such action is respectfully requested.

Should this Review Board have any further questions or comments that need be addressed in order to obtain allowance, it is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

By:



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